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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,955	10/24/2001	Trevor Harms	051373-0115	8428

26371 7590 02/23/2005

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EXAMINER	
BLENMAN, AVALON	
ART UNIT	**PAPER NUMBER**
2153	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/039,955	HARMS ET AL.	
	Examiner	Art Unit	
	Avalon Blenman	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☒ Claim(s) *12,19* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-21 are pending in this application

Claim Objections

Claims 12 and 19 are objected to because of the following informalities; appropriate correction is required.

In referencing to claim 12, it is suggested applicant make the word contact plural (line 7).

In referencing to claim 19, it is suggested applicant remove second period after the word device (lines 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 4-7, 11-13, and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara et al. (US Patent 5,938,725), hereafter referred to as Hara in view of Haynes et al. (US Patent 6,442,591), hereafter referred to as Haynes, in further view of Creswell et al. (US Patent 6,564,264), hereafter referred to as Creswell.

In referencing to claims 1 and 21, Hara discloses a method of (fig. 2) and system for (fig. 1):

- (means for) extracting (fig. 2, steps S2 & S3) contact information (electronic mail address) from a number of messages stored in a memory (fig. 1, #10, storage apparatus, col. 5, lines 53-55) in a device (col. 6, lines 54-58, 64-67); and

Hara does not explicitly disclose that the extracted contact information (mail address) is entered into a contact list. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara as evidenced by Haynes.

In analogous art, Haynes discloses a method (fig 4, steps 42, 44, & 52) of and system for (fig. 1) populating a contact list on a device by extracting (stripping) contact information from messages (col. 4, lines 31-33). Haynes further discloses:

- (means for) entering (storing) the extracted (stripped / retrieved) contact information (electronic mail address) into a contact list (fig. 2, #24,

retrieved contact list) maintained by a program operating on the device (col. 4, lines 47-53)

Both Hara and Haynes are silent as to if their devices (Hara, fig. 1, Haynes, fig. 2, #14) are portable devices. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara in view of Haynes as evidenced by Creswell.

In analogous art, Croswell discloses a method (fig. 2, steps 201, 203, 215, & 217) of populating a contact list (fig. 1, #30, user's address book) on a portable device (fig. 1, #15, wireless handset) by extracting contact information (address) from [returned] messages (col. 4, lines 4-7, 30-36).

Given these features, a person of ordinary skill in the art would have readily recognized the advantages and desirability of combing the teachings of Hara (extracting method/system) and Haynes (stored contact list) in view of Creswell (portable device) where Hara's and Haynes' methods of extracting contact information and populating a contact list could be implemented on Croswell's portable device.

The motivation for doing so would be so that the retrieved addresses are automatically stored to a contact list and are conveniently accessible at any time (see, Haynes, col. 4, line 48-53), via the internet or a portable device (see Haynes col. 1, lines 36-42), which is more likely to be with the user at all times.

In referencing to claim 12, Hara discloses a user interface (fig. 1, #13, output apparatus, col. 6, lines 22-26). Hara further discloses:

- means for extracting contact information (electronic email address) from a number of messages stored in a memory in a device (fig. 2, steps S2 & S3);

- means for presenting the extracted contact information (electronic mail address) on a device (fig. 1, #13, output apparatus);

Although Hara teaches these features, Hara does not explicitly disclose storing extracted contact information in a contact list. As set forth above in reference to claim 1, Haynes discloses:

- means for receiving (fig. 4, step 44) a number of selections of contact to be stored in the contact list; and

- means for entering (fig. 4, step 52) the selected contact information into a contact list (fig. 2, #24, retrieved contact list) maintained by a program operating on the device

Although Hara in view of Haynes teach all of these features, neither explicitly disclose a portable device. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara in view of Haynes as evidenced my

Creswell. As set forth above in reference to claim 1, Creswell discloses a portable device (fig. 1, #15, wireless handset).

Given these features, a person of ordinary skill in the art would have readily recognized the advantages and desirability of combing the teachings of Hara (extracting method/system) and Haynes (stored contact list) in view of Creswell (portable device) where Hara's and Haynes' methods of extracting contact information and populating a contact list could be implemented on Croswell's portable device.

The motivation as set forth above in reference to claim 1, would be so that the stored contact list is conveniently accessible at any time via the portable device.

In referencing to claim 16, Hara discloses a processing system (fig. 1) comprising:

- a central processing unit (CPU) (fig. 1, #12)

Hara does not explicitly disclose a CPU coupled to a storage device having stored there information for configuring the CPU. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara as evidenced by Haynes.

In analogous art, Haynes discloses that the user device is a PC having a CPU for executing a process (col. 3, lines 34-37). A computer running any application will inherently have a CPU connected to a storage device (ROM, RAM, hard drive, etc.) having stored there information for configuring the CPU. Therefore, Haynes inherently

discloses a storage device coupled to a processor and having stored there information for configuring the CPU.

Hara discloses a CPU configured to:

- extract (fig. 2, steps S2 & S3) contact information (electronic mail address) from a number of messages stored in a memory (fig. 1, # 10, storage apparatus) in a device (col. 6, lines 54-58, 64-67)

Haynes further discloses a CPU configured to:

- enter (store) the extracted (stripped/retrieved) contact information (electronic mail address) into a contact list (fig. 2, #24, retrieved contact list) maintained by a program operating on a device (col. 4, lines 47-53)

Although Hara in view of Haynes teach all of these features, neither explicitly disclose a portable device. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara in view of Haynes as evidenced my Creswell. As set forth above in reference to claim 1, Creswell discloses a portable device (fig. 1, #15, wireless handset).

Given these features, a person of ordinary skill in the art would have readily recognized the advantages and desirability of combing the teachings of Hara (extracting method/system) and Haynes (stored contact list) in view of Creswell (portable device)

where Hara's and Haynes' methods of extracting contact information and populating a contact list could be implemented on Croswell's portable device.

The motivation as set forth above in reference to claim 1, would be so that the stored contact list is conveniently accessible at any time via the portable device.

In referencing to claims 2 and 17, Hara in view of Haynes and Croswell teach all the limitations of claims 1 and 16 as set forth above. Hara does not explicitly disclose a method of monitoring incoming messages and retrieving contact information. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara as evidenced by Haynes. Haynes discloses a method, wherein extracting contact information includes:

- (CPU configured for, claim 17) monitoring incoming messages (email even occurrence) and retrieving contact information (electronic mail addresses) from incoming messages (col. 4, lines 31-33)

Given this feature, a person of ordinary skill in the art would have readily recognized the advantages and desirability of combing the teachings of Hara and Haynes in view of Croswell where the contact information is retrieved at the time the message is received.

The motivation for doing so would be so that the updated contact information is automatically stored without later having to parse the received messages stored in memory to extract the contact information therein (see Haynes col. 4, lines 48-52).

In referencing to claims 4 and 18, Hara discloses extracting contact information includes:

- (CPU configured for, claim 18) scanning ("sequentially reading", col. 6, lines 54-56) a message database (fig. 1, #10, storage apparatus) and retrieving (extracting) contact information (electronic mail address) from messages contained in the database (col. 6, lines 64-67).

In referencing claims 5 and 6, Hara discloses: (col. 6, lines 49-58, fig. 2, step S1):

- the scanning ("sequentially reading") occurs since a certain time (since the user inputs a key word)

[The scanning takes place every time the user inputs a keyword to be searched (fig. 2, step S1). It is therefore inherent that the next scan will take place when the user enters the next keyword to be searched (after the last/previous scan). Therefore, Hara inherently discloses:

- wherein the certain time is the time of the last scanning

In referencing to claims 7 and 19, Hara discloses (col. 6, lines 27-37):

- (CPU configured for, claim 19) providing a graphical user interface (GUI) (fig. 1, # 13, output apparatus) with contact information (electronic mail address) configured to receive a selection from a user of the device (fig. 2, #14, selection apparatus)

In referencing to claims 8, 15, and 20, Hara in view of Haynes do not explicitly disclose only entering contact information not already on the contact list. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara and Haynes as evidenced by Croswell. In analogous art, Croswell discloses:

- (means for, claim 15 / CPU configured to , claim 20) automatically entering in the contact list only contact information not already contained in the contact list ("no" condition, col. 4, lines 30-36, col. 5, lines 18-20)

Given this feature, a person of ordinary skill in the art would have readily recognized the advantages and desirability of combing the teachings of Hara and

Haynes in view of Croswell where the contact list is automatically updated only with new entries.

The motivation for doing so would be to so of the retrieved addresses, only the nonsexist entries are automatically stored and no selection is required from the user.

In referencing to claim 11, Hara discloses that the sender email information (fig. 4, address 5) could be differentiated from all of the extracted contact information (col. 3, lines 51-60). Hara does not explicitly disclose that the contact information is filtered to only include the sender email information in the contact list. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara as evidenced by Haynes.

As set forth in reference to claim 1, Haynes discloses entering (storing) extracted (stripped / retrieved) contact information (electronic mail address) into a contact list (fig. 2, #24, retrieved contact list).

Given this feature, a person of ordinary skill in the art would have readily recognized the advantages and desirability of combing the teachings of Hara in view of Haynes to filter all the extracted contact information to only include the email information of the sender in the contact list.

The motivation for doing so would be to allow a higher priority to the sender ("FROM" field) of the message verses those address of the recipients ("TO" and/or "CC" fields) (see Hara col. 6, lines 9-17).

In referencing to claim 13, Hara implicitly discloses (col. 4, lines 2-11, col. 6, lines 33-37):

- providing a checklist of extracted contact information (electronic mail address)

[If the user is presented with extracted contact information, in the form of a list (plurality of transmission destination candidates) and the user is able to select from the list of candidates, it implicitly a checklist]

Claims 3, 9, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara in view of Haynes and Creswell, and in further view of Checkoway et al. (US Publication 2002/0133554), hereafter referred to as Checkoway.

In referencing to claim 3, Hara does not explicitly disclose an extracted Simple Mail Transfer Protocol (SMTP) email address. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara, Haynes, and Creswell in view of Checkoway.

In analogous art, Checkoway discloses a method of (step 572) of and system for (fig. 1) extracting contact information (sender e-mail) from incoming messages (page 1, paragraph 9, lines 7-10, page 3, paragraph 26, lines 1-6). Checkoway further discloses that communication is via SMTP e-mail (page 2, paragraph 19, lines 1-6, fig. 2, #204) Checkoway implicitly discloses:

- contact information (sender email) includes a simple mail transfer protocol (SMTP)

Given this feature, a person of ordinary skill in the art would have readily recognized the advantages and desirability of combing the teachings of Hara and Haynes in view of Croswell and Checkoway were the contact information extracted from the message would include a SMTP email address.

The motivation for using SMTP (SMTP email address) would be so that stored messages can later be retrieved using a Post Office Protocol (POP) and the email address extracted (see Checkoway, page 1, paragraph 17, lines 5-10, page 2, paragraph 19, lines 3-7, paragraph 24, lines 1-5).

In referencing claims 9 and 10, Hara and Haynes in view of Creswell teach all the limitations of claim 1 as set forth above. Hara and Haynes in view of Creswell do no explicitly teach filtering contact information to be included/excluded from a contact list according to a domain. Nonetheless, this feature would have been an obvious

modification to the system disclosed by Hara, Haynes, and Creswell as evidenced by Checkoway.

In analogous art, Checkoway discloses differentiating emails and addresses belonging to certain domains ("@halibot.com", page 7, paragraph 52, lines 7-17):

Given this feature, a person of ordinary skill in the art would have readily recognized the advantages and desirability of combing the teachings of Hara, Haynes, and Creswell in further view of Checkoway where contact information of emails from certain domains (claim 9) or retrieved address from certain domains (claim 10) could be filtered to be included/excluded from the generated contact list.

The motivation for doing so would be to differentiate between global and local address (see Checkoway, page, 7, paragraph 52, lines 9-17)

In referencing to claim 14, Hara and Haynes in view of Creswell teach all the limitations of claim 12 as set forth above. Creswell does not explicitly teach that his wireless handset is a Wireless Application Protocol (WAP) phone. Nonetheless, this feature would have been an obvious modification to the system disclosed by Creswell as evidenced Checkoway.

In analogous art, Checkoway discloses a means for presenting extracted information in the form of a WAP response (page 2, paragraph 19, lines 21-24).

Given this feature, a person of ordinary skill in the art would have readily recognized the advantages and desirability of combing the teachings of Hara and

Haynes in view of Creswell in further view of Checkoway where the GUI of the device would include a display on a WAP phone.

The motivation for doing so would be so the information would be available on demand via a small portable device (see Checkoway, page 1, paragraph 7).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avalon Blenman whose telephone number is (571) 272-5864. The examiner can normally be reached on Mon-Fri, 7:00 AM - 4:30 PM (even date Mons. off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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